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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,123	03/07/2000	DIETMAR DETERING	21164	9814

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EXAMINER

LINZEY, DAVID

ART UNIT PAPER NUMBER

DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/520,123

Applicant(s)

DETERING, DIETMAR

Examiner

David Linzey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5-6. 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
 - “safe \$40” in the last paragraph of page 19 should be changed to “save \$40.”
 - On page 23, the spacing between the table and the paragraph beneath the table needs to be increased.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As per claim 12, a family of differentiated substitutable goods that contain only one good that cannot be substituted is a conflicting statement. If there is only one good, how can there be a family? If something is substitutable, how can there be no substitute?

As per claims 13 – 16, what the applicant regards as Clarke’s Demand Revealing Process should be defined specifically. Does the applicant consider there to be any other steps in the Demand Revealing Process? Is the Demand Revealing process after Clarke in claim 14 the same as Clarke’s Demand Revealing Process in claim 13? Are 14(a & b) the Demand Revealing Process as in Fig. 5?

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The statement in claim 1(e) regarding a price lower than the group’s “supposed

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“marginal willingness to pay” is indefinite. The word “supposed” suggests that this may not be the group’s willingness to pay. If it is not, there is no definite amount that the purchase of the options should be. If there were another amount to consider, the method would have to be able to calculate that amount in order for the purchasing amount to be as low or lower. Also, there is not a definition for a “supposed marginal willingness to pay.” The examiner questions whether there is a difference between the similar definitions willingness to pay, “supposed willingness to pay”, “aggregate willingness to pay” or “marginal willingness to pay”?

Because claims 2 – 16 are dependent on claim 1, they are also indefinite.

In claim 17(d), the phrase “long term” is indefinite. What period of time does the applicant consider this to be?

In claim 19, what does the applicant regard as previous?

Because claims 18 – 26 are dependent on claim 17, they are also indefinite.

As per claim 26, “said voting sample” lacks clear antecedent basis.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 - 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, particularly, an abstract idea.

The Examiner notes that the disclosed invention is within the technological arts. The claimed invention is also noted not to be a computer program, data structure, a natural phenomenon, a non-descriptive material per se. The claimed invention does not include a series

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of steps to be performed by a computer. The claimed invention also is not a product for performing a process, nor is it a specific machine or manufacture. The claimed invention is not a specific tangible machine or process for facilitating a business transaction. Claims 1 – 26 do not appear to correspond to a specific machine or manufacture disclosed within the instant specification and thus encompasses any product of the class configured in any manner to perform the underlying process. Claims 1 - 26 do not appear to correspond to a specific machine or manufacture, and thus encompass any product of the class configured in any manner to perform the underlying process. The claimed invention of claims 1 – 26 also do not include a post-computer process activity or a pre-computer process activity. Thus, no physical transformation is performed, no practical application in the technological art is found. Consequently, claims 1 – 26 are analyzed based upon underlying process, and are thus rejected as being directed to a non-statutory process.

Claims 4 and 19 are purely the thought processes behind a group and do not fit into any patentable category.

Claim Objections

4. The claims in this application do not commence on a separate sheet in accordance with 37 CFR 1.52(b). Appropriate correction is required in response to this action.

Claims 25 and 26 are tabbed differently.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 – 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien et al. U.S. Patent 5,689,652 in view of Stallaert et al. U.S. Patent 6,035,287.

As per claims 1, 9, and 17, Lupien discloses selling options at various price/quantity combinations. These combinations are matched with a buyer's willingness to buy profile. The profiles are ranked and matched with the sell orders. Groups of buyers can buy their willing amount of stock based on their profile. The examiner interprets the price/quantity combination to be the marginal cost of the present invention. This cost in Lupien may be more or less than the cost to produce based on the security's price on the market at the time.

The system in Lupien chooses the ranked matches to distribute the portions of the desired stock to different individuals. This practice groups consumers based on their willingness to pay. This definition fits the present invention's bundling consumers. Anyone matched will have the right to use their options as they see fit.

Lupien does not explicitly disclose differentiated and substitutable goods. Stallaert discloses differentiated and substitutable goods. The examiner interprets the Stallaert bundling of goods (col. 2 lines 37 – 40) to be the differentiated and substitutable goods described in the present invention. Neither patent explicitly discloses an auction but auctions are old and well

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known. It may be inferred that the system of Lupien is a type of blind auction. The buyers are not grouped or tied to any one option unless it is determined by the system necessary to satisfy their willingness to pay. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Lupien to include the Stallaert good bundling and an auction to ensure selling goods at a desirable price.

As per claim 2, Lupien discloses purchasing in many rounds. An offering of a basket of securities may be bought by a number of buyers. The examiner considers this to be different rounds of disposal of the security for sale.

As per claims 3 and 18, Lupien does not disclose differentiated and substitutable goods. Stallaert discloses bundling differentiated goods (Fig. 4 lines 29 – 33). Fig. 1 shows 4 different assets with for bundle 100a with a different proportion of each asset. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Lupien to include the Stallaert differentiated good bundling to make the bundles more attractive for the buyer.

As per claims 5, 6, 20 and 21, the applicant is simply describing a rental transaction. A person or entity pays for the right to use something that is still under the control of another party. The practice of controlling the utilization of something that another has paid to use is old and well known. It would have been obvious to one skilled in the art to modify the system of Lupien using the goods of Stallaert to include controlling utilization of use to keep the good in working condition for future use.

As per claims 7, 8, 22, and 23, any price paid for ownership or rental is in turn being paid to use an item. Most prices aren't set by the marginal cost so any price set for profit is different

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from the marginal cost price. If someone gives a gift, the price would be zero. In the alternative, if the price is 0, then the item is a gift and there is no price. If someone is paid for instance, to haul something off to the junkyard or paid to test a product, the seller is paying for someone else to use the good. All of these situations are old and well known. It would have been obvious to someone skilled in the art to modify the system of Lupien combined with the system of Stallaert to include a different use price than marginal price to make a larger profit.

As per claim 10, this is simply a group rate health club scenario. According to the quality and offerings of the club, you get a discounted price based on the number of times per period (month) you are expected to use the facilities. It would have been obvious to one skilled in the art to modify the system of Lupien combined with the system of Stallaert to include a group membership fee in order to attract more people to pay for the goods.

As per claim 11, prices being offered for acceptance or not is old and well known in business every day. It would have been obvious to one skilled in the art to modify the system of Lupien combined with the system of Stallaert to include a price being offered for acceptance in order to sell a product.

As per claim 24 and 25, see the discussion of claim 17 above. The examiner discusses an auctioning group formed in the group buying of Lupien. The same argument is incorporated herein.

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Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Linzey whose telephone number is 703-305-4570. The examiner can normally be reached on M - F 8-4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantzy Poinvil can be reached on 703-305-9779. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7658 for regular communications and 703-305-7658 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

DL
July 15, 2002

Frantzy Poinvil
FRANTZY POINVIL
PRIMARY EXAMINER
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